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10/595,697	05/05/2006	Sandro Gerd Thronicke	SCH003-US	4981

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EXAMINER
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WENDELL, MARK R

ART UNIT	PAPER NUMBER
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3635

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,697	<b>Applicant(s)</b> THRONICKE ET AL.	
	<b>Examiner</b> MARK R. WENDELL	<b>Art Unit</b> 3635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 1990.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-23 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 23 provide for the use of the decoupling and sealing system, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-9, 11-12 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Nakazawa (US 5238721).

Regarding claims 1, 12, 18 and 21, Gutjahr illustrates and teaches a multi-layer decoupling and sealing system, for laying ceramic paving using a thin-bed method with said system comprising:

- A sealing layer (20) that is impermeable to liquid, said sealing layer consisting of a non-woven anchoring material;
- An anchoring layer (30) that is configured from a lattice-type structural element and configured to hold a filler material (26) that is to be incorporated into the upper face of the decoupling and sealing system, said filler (26) being plastic during processing and subsequently cures.

However, the Gutjahr reference does not distinctly disclose a reinforcing layer above the anchoring and filler layer. The main object of the Gutjahr invention is to provide an underlayment for a tile floor which resists cracking and increases the stability of the floor. Nakazawa illustrates in Figures 1-3 and discloses:

- A reinforcing layer (5) which, at least in some sections, is rigidly disposed above said to the anchoring layer.

The examiner notes that Nakazawa illustrates an underlayment to a tiled floor system. Nakazawa goes on to state in column 3, lines 45-55, that an elastic coating or adhesive material can be placed on the back of the tile to aid in the

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resistance to lateral movement of the tiles, which is what Gutjahr is teaching with the adhesive mortar layer. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the Gutjahr tiling system with the addition of the reinforcement layer of Nakazawa in order to further resist lateral movement of the tiles (motivation found within Nakazawa) and to further aid in the resistance to cracking of the adhesive mortar (motivation found within Gutjahr).

Regarding claim 2, Gutjahr in view of Nakazawa teaches within column 4 and Figure 5 of Gutjahr the lattice-type structural element (30) formed from individual rods that are disposed to one another in the manner of a lattice and fixed to one another at the points of intersection of the lattice. The examiner notes that the lattice structure is described as a laminated textile mesh, which confirms that the lattice structure is a unitary structure and the individual rods are disposed to one another.

Regarding claims 3 and 4, Gutjahr in view of Nakazawa teaches in Figures 5-10 of Gutjahr that the individual rods (16a and 16b) are of an essentially rectangular cross-section and the rods are placed in layers at an angle. The examiner notes that the angle appears to be a 90 degree angle.

Regarding claim 5, Gutjahr in view of Nakazawa illustrates in Figure 5 of Gutjahr that the lattice structure (30) is rectangular in shape.

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Regarding claims 8 and 9, Gutjahr in view of Nakazawa illustrates in Gutjahr a continuous vapor pressure equalizing layer within the underlayment (item 10 of Figure 1). The specification of Gutjahr states that the layer contains a plastic film (12). The examiner notes that polyethylene is a well-known plastic.

Regarding claim 11, Gutjahr in view of Nakazawa teaches within Gutjahr that the underlayment is secured together via a mortar-filler layer (26).

Regarding claims 14-17, Gutjahr in view of Nakazawa teaches in column 4 of Gutjahr that the decoupling system is cemented via sealing slurry to the concrete substratum. The examiner notes that neither reference teaches the exact material the slurry is made from; however it is well-known in the art that slurry can include polyethylene. The examiner also notes that regarding claim 14, the fact that the floor can float on a substratum lacks criticality given that the subsequent claim 15 teaches that the system is cemented to the substratum. It is well-known in the art to fasten decorative flooring surfaces to the substratum and to leave the surface floating on the substratum. To one of ordinary skill in the art, a floating floor is well-known to be much easier to replace if a user so chooses.

Regarding claims 19 and 20, Gutjahr teaches in column 4, lines 10-20 the rough dimensions of the underlayment / sealing system (4-14mm). The examiner notes that it

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has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233).

Regarding claims 22 and 23, the examiner notes that these claims are use claims only claiming possible uses for the decoupling / sealing system. The system of Gutjahr in view of Nakazawa is completely capable of being used as a facade or a barrier element.

Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Nakazawa (US 5238721) as applied to claim 1 above, and further in view of Barth et al. (US 6171015). It is described above what is disclosed by Gutjahr in view of Nakazawa; however regarding claims 6 and 10 the references do not distinctly disclose the individual rods being welded to one another or the reinforcing layer being welded to the anchoring layer. However, the references do show the layers being attached to one another and Barth teaches in column 3, lines 61- 67, "as far as the joint between adjacent elements of the supporting structure is concerned, provision can also be eventually made here so that the elements are positively connected to one another by clamp-shaped parts, by adhesive bonding or by welding." Therefore it would be obvious to one of ordinary skill in the art to substitute adhesive bonding for a weld and to weld adjacent layers together for stability purposes for the entire structure. The examiner notes that no unexpected results from welding as opposed to any other form of fastening are documented by the applicant and it is believed that any form of

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fastening, especially when the layer is placed into a mortar-type substance, which subsequently hardens, would be better than another form of fastening.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Nakazawa (US 5238721) as applied to claim 1 above, and further in view of Nortene Technologies (FR 2774715). It is described above what is disclosed by Gutjahr in view of Nakazawa; however regarding claim 7 the references do not specifically disclose the individual rods having an undercut section. Nortene illustrates in Figure 1 the intersection of the rods having an undercut section. It would have been obvious to one having ordinary skill in the art at the time of invention to have the intersection of the rods have undercut sections for a more secure connection between the adjacent rods. The examiner notes that both Nortene and Gutjahr teach a lattice-type structural layer that is a textile mesh used in an underlayment for tiling, and therefore are considered analogous art.

#### ***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The examiner notes that none of the closest prior art references teach a reinforcing layer being longer than another layer.



***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Richard E. Chilcot, Jr./

Supervisory Patent Examiner, Art Unit 3635

/M. R. W./

Examiner, Art Unit 3635

April 7, 2009